

**TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

CME

#85383850

Mailed: July 9, 2013

Opposition No. 91207992

Hachette Filipacchi Presse

v.

Cheo Green

Before Quinn, Kuhlke, and Mermelstein,  
Administrative Trademark Judges:

By the Board:

On January 15, 2013, the Board issued a notice of default due to applicant's failure to timely file an answer to the notice of opposition or a motion to extend his time to answer. The Board allowed applicant thirty days in which to show cause why default judgment should not be entered. Now before the Board is applicant's response to the notice of default, filed February 8, 2013 ("Applicant's Response"), and opposer's response thereto, filed February 21, 2013 ("Opposer's Filing"). Opposer "does not oppose" setting aside the notice of default," Opposer's Filing, p. 1, but disputes applicant's assertion that "the opposition should not have been instituted." Applicant's Response, p. 2.

By way of background, applicant seeks registration of the mark ELLE JOLIE, in standard characters, for women's



\*07-31-2013\*

Opposition No. 91207992

clothing, namely, shirts, dresses, skirts, blouses.”<sup>1</sup> On November 14, 2012, the last day of its extended opposition period, opposer filed a notice of opposition against the involved application on grounds of priority, likelihood of confusion and dilution, and included a certificate of service, attesting to serving the notice of opposition via first class mail on applicant at applicant’s address, as opposed to applicant’s correspondence address of record, in this case the address of applicant’s attorney of record. Trademark Rule 2.101, 37 C.F.R. § 2.101. That same day, the Board instituted the proceeding, e-mailing copies of the institution order to counsel of record for both parties. On November 15, 2012, opposer served a copy of the notice of opposition on applicant’s counsel via e-mail.

Applicant asserts that he “was never served by mail with the [n]otice of [o]pposition” because he never received the notice of opposition and “proof of service assumes actual service upon the [a]pplicant.” Applicant’s Response, pp. 1-2. Applicant further contends that he never consented to service by e-mail. See *id.* at p. 2. Opposer argues that it effected proper service by sending the notice of opposition via first-class mail directly to applicant.

---

<sup>1</sup> Application Serial No. 85383850, filed on July 28, 2011, based on applicant’s allegation of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Opposition No. 91207992

Opposer's Filing, p. 1. Opposer further asserts that applicant's "authorization of correspondence by e-mail is set forth in the [involved] [a]pplication" and that it "never received any bounce-back e-mail or any other indication that delivery of the e-mail was not completed." *Id.* at pp. 1-2.

Under Trademark Rule 2.101, an opposition is commenced when three conditions are met: (1) a timely notice of opposition is filed with the required fee; (2) opposer makes sufficient efforts to serve the notice of opposition; and (3) the Board is notified of the service at the time the notice of opposition is filed. *Cf. Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) (opposer included certificate of service via ESTTA filing but failed to actually serve a copy of the notice on applicant at any time during the proceeding; case dismissed as nullity); *Schott AG v. Scott*, 88 USPQ2d 1862 (TTAB 2008) (opposer failed to include a certificate of service with the notice of opposition, filed via first-class mail, and did not dispute its failure to actually forward service copies to applicant; case dismissed as nullity).

Elements one and three have been satisfied. Opposer timely filed its notice of opposition which incorporated a

certificate of service.<sup>2</sup> We note, however, that the certificate in the electronic cover page, referencing service on the address of record (which under Trademark Rule 2.101 means the correspondence address of record, in this case, the attorney's address), is contradicted by the certificate of service in the attached complaint which references applicant's address, rather than the correspondence address of record. With respect to element two, applicant does not dispute that opposer served the notice of opposition contemporaneously with the filing of the opposition, as stated in the certificate of service, but rather contends that applicant never received it. Opposer indicated in the certificate of service in the complaint and in response to the motion that he served a copy of the notice of opposition on applicant via first-class mail. Although the certificate of service reflects service on applicant as opposed to applicant's counsel of record, there is no evidence that this mistake was anything but inadvertent, and the Board's institution order alerted applicant's counsel to the notice of opposition on the day it was filed. Moreover, while we agree that applicant's consent to receive e-mail correspondence from this Office

---

<sup>2</sup> By utilizing ESTTA, as opposer did here, a plaintiff is assured that the notice of opposition will contain a certificate of service. See *Schott AG*, 88 USPQ2d at 1863 n.3 ("[A]ny plaintiff who files [a notice of opposition] through ESTTA is

does not constitute an agreement to accept service of papers in this proceeding via e-mail, applicant does not dispute that he received the e-mail copy of the notice of opposition sent the next day. In view of these circumstances, we conclude that opposer made sufficient efforts to serve the notice of opposition.

We turn now to the notice of default. "However the issue [of default] is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard." TBMP §§ 312.01 and 508. Under Fed. R. Civ. P. 55(c), default may be set aside "for good cause." As a general rule, good cause will be found where the defendant's delay is not the result of willful conduct or gross neglect, where prejudice to the plaintiff is lacking, and where the defendant has a meritorious defense. *See Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991). Moreover, the Board is reluctant to grant judgments by default, since the law favors deciding cases on their merits. *See Paolo's Assocs. Ltd. P'ship v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).

Applicant's failure to timely file an answer was not the result of willful conduct or gross negligence and

---

viewed by the Board as having included proof of service with its

opposer will not suffer prejudice given that this proceeding is in its earliest stages. Although applicant has not yet filed an answer, he has addressed the substantive allegations of the notice of opposition in his response, at least in part, arguing that the parties' marks "are not substantially similar and there is not a likelihood of confusion between these two marks." Applicant's Response, p. 2. Accordingly, the Board's January 15, 2013 notice of default is hereby **SET ASIDE** and applicant is allowed until **July 29, 2013** to file an answer. Conferencing, disclosure, discovery, trial and other dates are hereby reset as follows:

Time to Answer	7/29/2013
Deadline for Discovery Conference	8/28/2013
Discovery Opens	8/28/2013
Initial Disclosures Due	9/27/2013
Expert Disclosures Due	1/25/2014
Discovery Closes	2/24/2014
Plaintiff's Pretrial Disclosures	4/10/2014
Plaintiff's 30-day Trial Period Ends	5/25/2014
Defendant's Pretrial Disclosures	6/9/2014
Defendant's 30-day Trial Period Ends	7/24/2014
Plaintiff's Rebuttal Disclosures	8/8/2014
Plaintiff's 15-day Rebuttal Period Ends	9/7/2014

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

---

pleading." ).

· Opposition No. 91207992

· Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

\*\*\*

United States Patent and Trademark Office  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA, 22313-1451  
If Undeliverable Return in Ten Days

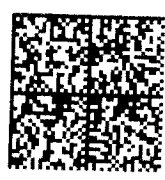
OFFICIAL BUSINESS  
PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER

91207992

THOMAS K RICHARDS  
249 SKILLMAN AVE  
BROOKLYN, NY 11211

*TA*



UNITED STATES POSTAGE  
0.2 1M  
0004244994  
JUL 17 2013  
MAILED FROM ZIP CODE 22314  
\$ 00.66<sup>0</sup>

22313145151

NIXIE 100 DE 1999 0007/27/13  
RETURN TO SENDER  
INSUFFICIENT ADDRESS  
UNABLE TO FORWARD  
BC: 22313145151 \*1992-00392-27-43